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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,736	08/04/2003	Ed Kopidlansky	EKJ-101	5590
42419	7590	11/10/2004	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195			HOESLY, RYAN C	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/633,736	KOPIDLANSKY, ED	
	Examiner	Art Unit	
	Ryan C. Hoesly	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/04/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/20/03</u>  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "at least one bracket matches an ornamental feature of the top plate," as in claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "threaded aperture lined with a stainless steel wire insert," as in claims 5 and 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: frame assembly 145 (page 13, line 6). Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-14, 17, 21, 25, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Petersen (US Patent Number 6659547). Petersen teaches an adjustable back rest and cargo carrier for a motorcycle, which includes a carrier rack (30) that comprises brackets (32 and 34), a top plate (160), and a means for attachment including a cover plate or carrier sub frame bar (44) connected to the lock plate (54) by fasteners (50).

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6. With regards to claims 1-11, 13, 14, 17, 21, and 28, the top plate is removably attached through apertures with fasteners (column 6, line 28) to the corresponding threaded apertures in the upper edge of the brackets that are also removably attached to the carrier sub frame bar through corresponding apertures that connect the brackets and the cover plate with fasteners. The top plate and brackets are functional luggage carriers and they match the decorative theme of the Petersen device, however it would be within the scope and spirit of the Petersen device to alter the embodied theme to include other designs or to use interchangeable decorative parts. Petersen also discloses that the carrier sub frame bar is attached by fasteners to the lock plate through corresponding apertures in the lock plate and the carrier sub frame bar. Additionally, both the carrier sub frame bar and the lock plate are positioned against the upright bars extending upwards to define the back rest.

7. With regards to claim 12, 25, and 27, the carrier sub frame bar that Petersen discloses clamps against the locking plate, thus making it inherently capable of being referred to as a clamping block or a cover plate and functioning as claimed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen as applied to claims 1-14, 17, 21, 25, 27, and 28 above, and further in view of Dreiling (US Patent Number 5845830). Dreiling teaches a bicycle attachable seat assembly for carrying objects that includes the following: a removable top plate carrier (10) attached to a support bracket (24) through corresponding apertures by elongated fastening devices (84), a removable bracket attached to a lock plate (86) through corresponding apertures by elongated fastening devices (94), and a lock plate attached to a clamp block (88) attached through corresponding apertures by elongated fastening devices (106) whereas the lock plate and the clamping block are positioned on opposite sides of the upright bar member and having the thickness in the centers milled out so that the lock plate and the clamping block both form U-shaped channels that are flush around the upright bar member. The Dreiling device is inherently capable of attaching to upright members at angles or directly above a female sleeve on the upright member so that downward movement is prevented. There are many attachment devices for a carrier to an upright member, the Petersen device uses a sub frame bar and the Dreiling device uses U-shaped clamping blocks to achieve the same purpose, therefore, it would have been obvious to one skilled in the art at the time of invention to modify the attachment device for the carrier on the Petersen device to one as in the technology of Dreiling.

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10. Claims 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen as applied to claims 1-14, 17, 21, 25, 27, and 28 above, and further in view of Holtzclaw (US Patent Number D325820). Holtzclaw teaches a carrying case for firearms that is of a size and shape and has the necessary means to serve as a cover for a metal plate and particularly the top plate of the motorcycle luggage rack system. Sheaths for protecting metal articles are well known in the art and so it would have been obvious to one skilled in the art at the time of invention to put a sheath over the metal plate for protection such as in the technology disclosed by Holtzclaw.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record can be found in the Notice of References Cited (PTO Form-892). Particular attention should be given to the website in the Non-Patent Literature,

<http://soetengadesign.com/slimline%20racks.htm>, which discloses motorcycle luggage racks with top plates having varying designs including a flame, a skull, and a Maltese cross.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan C. Hoesly whose telephone number is (703) 305-0576. The examiner can normally be reached on Monday-Thursday 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax

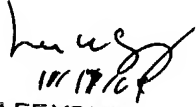


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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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